

REMARKS

Upon entry of the present amendment, Claims 1-20 remain in the application, of which claims 1, 6-9, 12 and 20 are independent.

The applicant gratefully acknowledges the indication by the Examiner that claims 2-3, 6-11, and 12-19 contain allowable subject matter. Claims 12-19 are allowed outright, and claims 2, 3, and 6-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

After careful consideration of the objections and rejections set forth in the Office Action, applicant respectfully submits that as amended, all pending claims patentably distinguish over the art of record, and requests allowance of all pending claims, as discussed further below.

Claim rejections 35 USC 103

Claims 1, 4, 5, and 20 have been rejected under 35 USC 103(a) as being unpatentable over Kobayashi et al in view of Thien. The Examiner states that Kobayashi discloses a coupling cover and a method for covering a coupling, but that Kobayashi does not disclose a cover with first and second sections which are removable. Thien et al teach a cover with first and second sections that are removable. It is the Examiner's position that it would have been obvious to form the device of Kobayashi et al with a cover with first and second sections that are removable as taught by Thien et al for improved sound reducing and ease of assembly.

Upon review of these references, the applicant notes that Kobayashi discloses a water jet propulsion unit and related cover structure for a personal watercraft, in which the jet propulsion unit is pivotally movable between a downwardly facing in-water position and a raised, out-of-the water position. The cover structure of Kobayashi covers the engine and the jet propulsion unit,

but the cover structure of Kobayashi fails to include a removable two-part cover which covers a shaft coupling between the crankshaft and a propeller shaft, as recited in claim 1 and in claim 20.

Thien discloses a sound-proof casing structure for housing an internal combustion engine. Although the cover of Thien includes a lateral aperture 7 for permitting passage of a crankshaft or a flywheel flange 8 (Figure 2), Thien fails to teach, disclose or suggest a cover structure of the type described in claim 1, including structure configured to cover a shaft coupling between the crankshaft and a propeller shaft. The sound-proof casing of Thien is not shown extending out beyond the flywheel of the engine. Also, the engine of Thien is not described in connection with a watercraft.

The applicant respectfully disagrees with the Examiner's rejection of these claims since Kobayashi fails to disclose a removable two-part cover which covers a shaft coupling between the crankshaft and a propeller shaft, and modification of Kobayashi by Thien does not correct the deficiencies of Kobayashi. Further, there is no suggestion for such a modification of Kobayashi found within either Kobayashi, which is directed to a movable jet propulsion unit, or to Thien which discloses a sound-proof casing structure for housing an internal combustion engine.

The Standard for Obviousness under Federal Circuit Law

Applicant respectfully wishes to call the Examiner's attention to some relevant cases of the U.S. Court of Appeals for the Federal Circuit (CAFC). The CAFC was established in 1982 to bring national standards, and a certain level of conformity and continuity to Federal patent case law. Decisions of the Federal Circuit are relevant and helpful in giving guidance to patent practitioners, as well as to the personnel of the U.S. Patent and Trademark Office.

The CAFC has stated that:

In order to determine obviousness as a legal matter, four factual inquiries must be made concerning: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the claimed invention and the prior art; and 4) secondary considerations of nonobviousness, which in case law is often said to include commercial success, long-felt but unresolved need, failure of others, copying, and unexpected results. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 877, 27 USPQ2d 1123, 1128 (Fed. Cir. 1993).

The U.S. Court of Appeals for the Federal Circuit has said that a reference must be viewed in its entirety, *Gore v. Garlock*, 220 U.S.P.Q. 303 (CAFC 1983), and that it is impermissible to use the claims as a frame, and the references as a mosaic, to pick and choose selected pieces, out of context, to reconstruct the invention, *Northern Telecom v. Datapoint*, 908 F.2d 931 (CAFC 1990).

The U.S. Court of Appeals for the Federal Circuit has also said that that in order to combine references, the Examiner must show some motivation, suggestion, or teaching of the desirability of making the combination, *In re Dembiczak*, 50 USPQ 2d 1614, 1617 (CAFC 1999); and that the use of hindsight, in evaluating patentability, is improper, *In re Werner Kotzab*, 55 U.S.P.Q. 2d 1313 (CAFC 2000); *Gore v. Garlock*, *supra*.

Specifically, in *Kotzab*, *supra*, the CAFC stated:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome, wherein that which only the invention taught is used against its teacher." *Id.*

Most, if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is

insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant (citations omitted).

Applicant submits that the above-quoted language of the Court of Appeals for the Federal Circuit has relevance to prosecution of the present application, with special reference to claims 1 and 20, and that the Examiner's preliminary position in the Office Action should be reconsidered and withdrawn.

As regards claim 20, the applicant disagrees with the Examiner's rejection of this claim since the cited references fail to teach the claimed method. For example, neither reference teaches a cover apparatus for a shaft coupling, and the apparatus of Thien is not related to a personal watercraft. Further, neither reference teaches or suggests lifting the second cover section of the cover apparatus off of the first cover section while leaving the first cover section installed, as recited in step 20b, and neither reference teaches or suggests accessing a shaft coupling while the cover remains in place, as recited in step 20c. Thus, the applicant considers claim 20 to be in condition for allowance.

However, in order to advance prosecution of this case, claim 1 has been amended herein to include the limitations of allowable claim 2, and claim 2 has been canceled. Further, claim 3 has been amended herein to depend from claim 1. As regards claims 3, 4 and 5, because these claims depend from claim 1, and because claim 1 is considered to be in allowable condition, these claims are also considered to be in condition for allowance.

Other matters:

Claims 6-9 have been amended herein to be rewritten in independent form by including the limitations of the base claim, claim 1, so as to obviate the Examiner's objections and to place these

claims into allowable condition.

Claims 10 and 11 depend from claims 8 and 9, respectively, and so are also considered to be in condition for allowance.

Claim 14 has been amended herein to correct an improper dependency. Specifically, claim 14 has been amended herein to depend from claim 13.

Conclusion

Based on all of the foregoing, applicant respectfully submits that all of the objections and rejections set forth in the Office Action are overcome, and that as presently amended, all of the pending claims are believed to be allowable over all of the references of record, whether considered singly or in combination.

Applicant requests reconsideration and withdrawal of the rejection of record, and allowance of the pending claims.


If the Examiner is not fully convinced of all of the claims now in the application, applicant respectfully requests that the Examiner telephonically contact applicant's undersigned representative to expeditiously resolve prosecution of the application.

The Commissioner is hereby authorized to charge the \$352.00 fee for four independent claims in excess of three to Deposit Account 50-0744 in the name of Carrier, Blackman & Associates, P.C. A duplicate copy of this sheet is enclosed.

Favorable consideration is respectfully requested.

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Respectfully submitted,


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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted, via facsimile, to Examining Group 3617 of the United States Patent and Trademark Office on October 14, 2004, at the number (703) 872-9306.

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